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09/988,985	11/19/2001	Byeong H. Jo	D0932-00178	9526

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EXAMINER

THOMPSON, CAMIE S

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 09/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/988,985

Applicant(s)

JO ET AL.

Examiner

Camie S Thompson

Art Unit

1774

-- Th MAILING DATE of this communication appears on the cover sheet with the corresponding address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 and 29-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-28 and 38-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6-7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. Applicant's amendment and accompanying remarks filed on June 27, 2003 have been acknowledged.
2. Examiner acknowledges amended claims 1-13.
3. Examiner acknowledges newly added claims 14-40.
4. Amended claims 1-13 and newly added claims 29-37 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Original claims 1-13 were directed towards a polymer composite building material. Amended claims 1-13 and newly added claims 29-37 are directed towards a method of making a polymer composite building material.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-21 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142 (b) and MPEP 821.03.5.

5. The rejection of claim 7 under 35 U.S.C. 112, second paragraph is withdrawn due to applicant's amended claim.
6. The rejection of claims 1-9 and 11-13 under 35 U.S.C. 102(b) as being anticipated by Novich et al., U.S. Patent Number 6,042,305 is withdrawn due to applicant's amended claims and arguments.
7. The rejection of claims 1-9 and 11-13 under 35 U.S.C. 102(b) as being anticipated by Woodside et al., U.S. Patent Number 6,125,905 is withdrawn due to applicant's amended claims and arguments.

Art Unit: 1774

8. The rejection of claims 1-5, 8-9 and 11-13 under 35 U.S.C. 102(e) as being anticipated by Fletemier is withdrawn due to applicant's amended claims and arguments.

9. The rejection of claims 1, 8-9 and 10 under 35 U.S.C. 103(a) as being unpatentable over Tucker et al., U.S. Patent Number 5,547,325 in view of Novich et al., U.S. Patent Number 6,042,305 is withdrawn due to applicant's amended claims and arguments.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1774

Claims 14-28 and 38-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8 and 15 of U.S. Patent No. 6,344,268 in view of Jambois, U.S. Patent Number 6,197,412. Both the Stucky reference and the instantly claimed invention disclose a polymer composite building material comprising a composite reinforcement comprising continuous fibers and a capstock material wherein dyes and pigments can be used to have a dark color for the capstock.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 14-28 and 38-40 are rejected under 35 U.S.C. 103(a) as being obvious over Stucky et al., U.S. Patent Number 6,344,268 in view of Jambois, U.S. Patent Number 6,197,412. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter

Art Unit: 1774

disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Stucky discloses polymer fiber composites and building materials such as fencing and decking wherein the material is hard and tough and has a wide range of properties including weatherability and high tensile strength as per instant claims 14 and 23 (see column 3, lines 5-21 and column 4, lines 37-47). In column 3, lines 5-21 of the reference, it is disclosed that the composite can be used with a capstock as per instant claims 15-17, 20-21, 23, 38 and 40. Stucky also discloses that the building material contains about 25-65 weight percent of fiber such as glass or carbon fibers as per instant claims 18-19 (see column 4, lines 59-63). It is disclosed in column 3, lines 62-68 that the composite can contain thermoplastic and thermosetting resins as per instant claim 27. The Stucky reference does not disclose that the capstock is dark in color as per the instant claims. Jambois teaches a fiber reinforced plastic component wherein the component can be a pultrusion and is durable and weather resistant (see column 1, lines 14-24). Jambois also teaches that the capstock may have pigments, ultraviolet absorbers or blockers. The dark color of the capstock provides higher thermoresistance. Therefore, it would have been

Art Unit: 1774

obvious to one of ordinary skill in the art to have a capstock with dark color in order to provide a composite that is weather resistant (see Jambois: column 2, lines 20-28). Additionally, the Stucky reference does not disclose the orientation of the fibers in the composite. Jambois teaches in column 4, lines 9-24 that the fibers can be lineal and forming mats of continuous omnidirectional or oriented fibers as per instant claims 24-25. Neither Stucky nor Jambois disclose the length of the fencing component. However, Stucky does disclose that the composite can be used for pasture fencing and posts. Pasture fencing and posts are conventionally greater than 8 feet. Therefore, it would have been obvious to one of ordinary skill in the art to have the fencing component be at least 8 feet in order to encompass an area required for pastures (see Stucky: column 3, lines 5-21).

### *Response to Arguments*

13. Applicant's arguments with respect to all the claims have been considered but are moot in view of the new ground(s) of rejection.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 1774

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Camie S. Thompson whose telephone number is (703) 305-4488. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly, can be reached at (703) 308-0449. The fax phone numbers for the Group are (703) 872-9310 {before finals} and (703) 872-9311 {after finals}.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

